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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,990	12/09/2005	Thanhchung Le	CPG 03-08 MB	6581
48418 7590 04/28/2008 PARKS KNOWLTON LLC 1117 PERIMETER CENTER WEST SUITE E402 ATLANTA, GA 30338				
EXAMINER				
GEHMAN, BRYON P				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
04/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,990

Applicant(s)

LE ET AL.

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,11-14,16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,11-14,16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The Office is hereby *sua sponte* waiving the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to 01 June 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with § 1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56. Applicants are advised that, notwithstanding the preceding waiver, an applicant who has not disclosed information that is material to patentability as defined in 37 CFR 1.56, because it was believed that the information was not "material to the examination," should disclose such information in order to discharge the applicant's duty of disclosure as required by 37 CFR 1.56, and should file a supplemental oath or declaration acknowledging that duty of disclosure.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-5, 11-14, 16 and 19-20 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 7, "said open side" lacks antecedent basis for one open side only, as lines 3-4 recite "at least one protruding receptacle having an open side", which is not disclosed such that plural receptacles would only define one open side, but rather that each receptacle

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would distinguish a respective open side. Accordingly, in line 7, "said open side" should be --one said open side--, as at least one open side is defined. See also claim 11, lines 5 and 11.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-14 and 16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Niemiec et al. (6,411,567). Disclosed is a package comprising a first card (202) comprising at least one protruding receptacle (204) having an open side, a conductive protective layer (104) mated to the first card so that the protective layer spans the open side, and a second card (208, 210 and 212) or a second (208) and third card (212) comprising a closed cell with circuitry (210) with a dielectric overlay (208 and/or 212), wherein the second card is mated to the first card so that the dielectric overlay is adjacent the protective layer and the closed cell is breachably aligned with the open side. To provide the dielectric overlay by printing on the second card appears to be conventional option within the level of ordinary skill in the art as referred to at column 5, lines 10-19, and it is not seen to distinguish any new or unexpected result from the prior art arrangement of Niemiec et al..

As to claim 12, the cards (202, 208-212) are non-conductive.

As to claim 13, a blister receptacle is typically pliable.

As to claim 14, the package includes an electronic monitoring device (408) in communication with the circuitry.

As to claim 16, a portion of the circuitry spans the closed cell.

6. Claims 1, 3-5 and 19-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Williams-Hartman (7,188,728) in view of either one of Niemiec et al. ('567) and Gordon (4,617,557) and additionally Johnstone et al. (6,047,829). Claims 1, 3-5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton et al. (5,172,812) in view of either one of Niemiec et al. ('567) and Gordon, and additionally Johnstone et al.. Williams-Hartman and Wharton et al. each disclose a medication package comprising a first card (201; 16; respectively) comprising at least one open cell (202; 17; respectively), a second card (101; 11) comprising at least one protruding receptacle (102; 13) having an open side, each protruding receptacle matingly nested within one open cell, a third card (104; 14); comprising a first closed cell, mated to the second card so that the first closed cell spans each open side, and a fourth card (301; 22) comprising a second closed cell mated to the third card so that the second closed cell is breachably aligned with the first closed cell, the cards being non-conductive. Niemiec et al. and Gordon each disclose providing a medication package with electric circuitry, with the electric circuitry (210; 2) breachably aligned with a closed cell spanning an open side of a card having a protruding receptacle (204; 4). To modify the medication package of either one of Williams-Hartman and Wharton et al. employing the

breachable electric circuitry of either one of Niemiec et al. and Gordon would have been obvious in order to provide an electronic compliance or management system to the package, as suggested by either one of Niemiec et al. and Gordon. Johnstone et al. provides the feature of a locking tab (106 or 106 and 108) provided on a layered medicinal package and disposed at a free end of the package to releasably retain the package within an outer sleeve. To further provide the package combination with a locking tab as suggested by Johnstone would have been obvious in order to serve as a locking mechanism as suggested by Johnstone et al. (see column 4, lines 34-44).

As to claim 3, a blister receptacle is typically pliable.

As to claim 4, a portion of the circuitry spans the closed cell.

As to claim 5, the package includes an electronic monitoring device (408) in communication with the circuitry.

7. Applicant's arguments filed January 30, 2008 have been fully considered but they are not persuasive. With respect to claim 1, the addition of a locking tab is rendered obvious by the new reference to Johnstone et al., where the addition of a locking tab to a medicinal package to provide a locking mechanism should the package be disposed in a sleeve is demonstrated.

With respect to claim 11, while the employed Figures on applicant's arguments on page 10 demonstrate a different arrangement between the prior art and applicant's structure, the claim 11 is not seen to delimit such a relationship, as both the protective layer and second card are described as mated to the first card, indicating that mating

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does not delimit any particular adjacency of the layers with respect to the first card, such as the manner demonstrated in applicant's Figure 1A of the arguments.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bryon P. Gehman/
Primary Examiner, Art Unit 3728

Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG